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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,750	07/28/2003	Philip G. Wessells	20003-7010	4856

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EXAMINER

EVANISKO, LESLIE J

ART UNIT PAPER NUMBER

2854

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

K.D.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,750	<b>Applicant(s)</b> WESSELLS, PHILIP G.	
	<b>Examiner</b> Leslie J. Evanisko	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electrostatic transfer system of claim 2, the ink ejection system of claim 3, the thermal transfer system of claim 3, the cartridge for storing the pad in claim 5, the adjustable cartridge for adapting to a plurality of pads of different cross-sections in claim 6, the transfer media using an edge laminate in claim 9, and the transfer engine including an aperture for ejecting ink in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The abstract of the disclosure is objected to because it uses language "The present invention includes...", which is language that should be avoided in the abstract. Correction is required. See MPEP § 608.01(b). Additionally, it is suggested that the term "An" in line 3 be deleted and replaced with --an-- to

correct a typographical error since the term is not at the beginning of a sentence.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It **should avoid using phrases** which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The disclosure is objected to because of the following informalities: The first page of the specification appears to be missing some information regarding the application serial numbers set forth in lines 7 and 8.

Appropriate correction and/or clarification is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The concept that the transfer media printed upon is the bottom-most transfer media of the pad as recited in claim 8 is not supported by the specification. Furthermore, the plurality of transfer media being secured using an edge laminate adhered to a

plurality of side edges of the plurality of transfer media in claim 9 is not properly supported by the specification. Finally, the transfer engine including an aperture for controllably ejecting ink from the cartridge as set forth in claim 12 is not supported by the specification.

### ***Claim Objections***

6. Claim 9 is objected to because of the following informalities: With respect to claim 9, the claim language regarding the edge laminate being adhered to a plurality of side edges appears to be inaccurate. In particular, as the language is currently recited, it appears that applicant is stating that edge laminate is provided on more than one edge of each sheet of transfer media. However, from the specification, it appears that applicant intends to recite that each sheet of transfer media has edge laminate applied to one side edge and the plurality of sheets are secured together along the one side edge including the edge laminate.

Appropriate correction and/or clarification is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 9, this claim is not properly further limiting the parent claim since the parent claim is drawn to the image transfer apparatus per se and not the combination of the image transfer apparatus and transfer media. Since claim 9 is only reciting further structure of the transfer media (which has been only functionally recited in claim 1), it makes the scope of the claims unclear as to whether applicant is intending to recite the transfer media as part of the claimed combination or not.

Similarly, with respect to claim 10, again this claim is not properly further limiting the parent claim since the parent claim is drawn to the image transfer apparatus per se. Note that what type of images are being printed upon the transfer media has no effect on the structure of the image transfer engine and therefore, this claim appears to be simply a function recitation of a desired mode of operation and fails to recite any further structure to provide that function. Thus, this claim fails to further properly limit the parent claim and instead renders the exact scope of the claim unclear, since it is not clear whether the images are intended to be part of the claimed combination or not.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4, 7-11, 13-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nukada (US 5,267,799). Nukada teaches an image transfer apparatus comprising a housing **10, 12, 14**, an image transfer engine **96**, and a transfer medium registration system **16, 38, 62, 80** for positioning a pad **1** including a plurality of transfer media releasably secured to one another, wherein the transfer registration system locates a series of individual ones of the transfer media at the transfer position to receive different images of the series of images. See Figures 1-3 in particular. Note the pages of the book **1** of Nukada are separate sheets bound together in some manner and therefore can broadly be considered to be a plurality of media “releasable secured” to one another. Furthermore, note that the pad is not part of the claimed combination and therefore, since the apparatus of Nukada includes a registration system capable of use with a pad as recited, it meets the claim language as broadly recited.

With respect to claims 4, 11 and 15, note the image transfer engine **96** is a thermal transfer printer system including a thermal head **97b** and replaceable ink ribbon cartridge **98b**, as described in column 8, lines 32-51.

With respect to claims 7-8, to the extent that the claim has defined what is meant by “top-most” or “bottom-most”, note that the apparatus of Nukada teaches printing upon transfer media which can broadly be considered to be either the “top-most” or “bottom-most” sheet, depending upon how the pad or book is viewed and/or inserted into the printer.

With respect to claims 9-10, again to the extent that the claims 9-10 are properly limiting the parent claim (see the above rejection under 35 USC 112), note that the image transfer apparatus of Nukada is broadly capable of being used with a pad as recited and capable of printing a series of images representing an animation sequence of modified related images, and thereby meets the functional recitations set forth in claims 9-10.

With respect to claims 13-14, note Nukada teaches a media flipper **62** for successively locating individual ones of the transfer media at the transfer location, as described in column 5, line 49-column 6, line 56. Note Nukada teaches the plurality of transfer media sheets are maintained “releasably secured” to the pad during the printing operation, as broadly recited.

With respect to claim 16, note Nukada teaches an image sequence transferring method comprising positioning a pad **1** at a transfer position of a transfer engine, the pad including a plurality of transfer media “releasable



secured” to one another, and transferring a series of images to successive ones of the transfer media serially positioned at the transfer position.

With respect to claims 18-19, note Nukada teaches the transfer medium (i.e., each printed page) is moved away (i.e., turned or flipped) from the transfer position after the transferring step while maintaining an attachment of the sheet to the pad.

With respect to claim 20, note Nukada teaches an animation printing apparatus as recited, including means for positioning **16, 38, 62, 80** a pad and means for transferring **96** a series of images to successive ones of the transfer media as recited.

11. Claims 1, 5-10, 13-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hübler (US 5,806,991). Hübler teaches an image transfer apparatus comprising an image transfer engine **5**, and a transfer medium registration system **2, 4, 6** for positioning a pad **1** including a plurality of transfer media **1a** releasably secured to one another, wherein the transfer registration system locates a series of individual ones of the transfer media at the transfer position to receive different images of the series of images. See Figures 1A-1D in particular. Note that the printing machine of Hübler inherently includes a housing of some form. Furthermore, note the pages **1a** of the book **1** of Hübler are separate sheets bound together in some manner (as described in column 1, lines 62-65) and therefore can broadly be considered to

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be a plurality of media “releasable secured” to one another. Furthermore, note that the pad is not part of the claimed combination and therefore, since the apparatus of Hübler includes a registration system capable of use with a pad as recited, it meets the claim language as broadly recited.

With respect to claim 5, note the registration system **2, 4, 6** of Hübler as described in column 2, lines 10-21 can broadly be considered to be a cartridge as recited.

With respect to claim 6, note the teachings in column 2, lines 22-27 and column 3, lines 28-36 of Hübler, which show the registration system **2, 4, 6** is capable of being used with pads of differing cross-sectional areas as recited.

With respect to claims 7-8, to the extent that the claim has defined what is meant by “top-most” or “bottom-most”, note that the apparatus of Hübler teaches printing upon transfer media which can broadly be considered to be either the “top-most” or “bottom-most” sheet, depending upon how the pad or book is viewed and/or inserted into the printer.

With respect to claims 9-10, again to the extent that the claims 9-10 are properly limiting the parent claim (see the above rejection under 35 USC 112), note that the image transfer apparatus of Hübler is broadly capable of being used with a pad as recited and capable of printing a series of images representing an animation sequence of modified related images, and thereby meets the functional recitations set forth in claims 9-10.

With respect to claims 13-14, note Hübler teaches a media flipper **4, 4b** for successively locating individual ones of the transfer media at the transfer location, as described in column 2, line 34-column 3, line 3. Note Hübler teaches the plurality of transfer media sheets **1a** are maintained “releasably secured” to the pad during the printing operation, as broadly recited.

With respect to claim 16, note Hübler teaches an image sequence transferring method comprising positioning a pad **1** at a transfer position of a transfer engine, the pad including a plurality of transfer media “releasable secured” to one another, and transferring a series of images to successive ones of the transfer media serially positioned at the transfer position.

With respect to claims 18-19, note Hübler teaches the transfer medium (i.e., each printed page **1a**) is moved away (i.e., turned or flipped) from the transfer position after the transferring step while maintaining an attachment of the sheet to the pad.

With respect to claim 20, note Hübler teaches an animation printing apparatus as recited, including means for positioning **2, 4, 6** a pad and means for transferring **5** a series of images to successive ones of the transfer media as recited.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nukada (US 5,267,799). Nukada teaches an image transfer apparatus as recited with the exception of the image transfer engine being an electrostatic transfer system or ink ejection system. Note that Nukada teaches the image transfer apparatus is a thermal transfer system including a replaceable cartridge containing a transfer medium (i.e., ink ribbon). However, other digital printer systems such as electrostatic or ink ejection systems are well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the printer to be an electrostatic or ink ejection system as recited, as it would simply require the obvious substitution of one known digital printing system for another, to provide a less complex digital printing mechanism for clear printing of the transfer media.

With respect to claim 12, an ink ejection system would inherently include an ink cartridge and an aperture for controllably ejecting the ink from the cartridge.

14. Claims 2-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hübler (US 5,806,991). Hübler teaches an image transfer apparatus as recited with the exception of the particular details of the transfer

engine. Note that Hübler teaches the printing arrangement is for digital printing processes in column 3, lines 22-23. Although Hübler is silent with respect to what type of digital printing processes it is referring to, digital printing processes including electrostatic, ink ejection, and thermal transfer systems are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide the digital printer structure of Hübler to be any recognized digital printing system (such as electrostatic, ink ejection, or thermal transfer) as it would simply require the obvious substitution of one known digital printing system for another to provide clear and accurate printing to the transfer media.

With respect to claims 11-12, note the use of a replaceable cartridge such as an ink ribbon cartridge or a liquid ink cartridge containing a transfer medium (i.e., ink) with a digital printing system such as a thermal printer or ink ejection system is well known in the art. Furthermore, an ink ejection system inherently includes an aperture for controllably ejecting the ink from the cartridge. Therefore, it would have been obvious to one of ordinary skill in the art to provide a digital printer structure including a replaceable cartridge and aperture for ejecting ink from the cartridge to allow for easier replacement of the ink when the supply is diminished.

15. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Nukada or Hubler as applied to the claims above, and further in view

of Matsugochi (GB 2 241 922 A). Each of Nukada and Hübler teaches a method as recited with the possible exception of the series of images collectively representing an animation sequence of modified related images. Note that both Nukada and Hübler are particularly drawn to printing data in a book and do not necessarily teach the data is a series of images representing an animation sequence. However, printing a pad or book with a series of images representing an animation sequence (i.e., a flip-book) is well known in the art, as exemplified by Matsugochi in Figures 7A-7B and described in pages 13-15 in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use the apparatus of either Nukada or Hübler to print an animation sequence on the successive pages of the book or pad as taught by Matsugochi to provide a flip book for instructional or entertainment use.

### ***Conclusion***


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Etienne (FR 2 689 816) teach a flip book with printed images having obvious similarities to the claimed subject matter.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone

number is **(571) 272-2161**. The examiner can normally be reached on M-Th  
7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168.  
The fax phone number for the organization where this application or  
proceeding is assigned is 703-872-9306.

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9197 (toll-free).

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
February 23, 2004